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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/662,344

DEC 07 2005

Filing Date: September 16, 2003

GROUP 3600

Appellant(s): NAGASAWA ET AL.

Manabu Kanesaka
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/22/2005 appealing from the Office action mailed 2/1/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US patent # 4,504,009	Boik et al.	March 12 1985
US patent # 4,761,319	Kraus et al.	August 2, 1988
US patent # 3,181,411	Mejlsø	May 4, 1965
US patent # 6,319,436	Jaeger et al.	November 20, 2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Boik (US 4,504,009). In the embodiment of Fig. 14, Boik discloses a hole plug comprising a head portion (55) and a foot portion extending from the back of said head portion. The foot portion includes a plurality of plate members (56) arranged in a cylindrical shape. Each plate member having a step (at 60) at a base (58) close to a head capable of engaging a hole (at 21). There is further provided a column (64) projecting from the back of the

head which includes s plurality of supporting means (75) also integral with the back of head for suppressing the plate member from bending. The column is read as being connected to each of the plate member through the supporting means since the claim does not require direct connection.

Claims 1, 2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraus (US 4,761,319). Kraus discloses a hole plug comprising a head portion (4) and a foot portion extending from the back of said head portion. The foot portion includes a plurality of plate members arranged in a cylindrical shape. Each plate member having a step (6) at a base (5,7) close to a head capable of engaging a hole (not shown). There is further provided a column (8') projecting from the back of the head which includes a plurality of supporting means (column 5, line 8-12). Kraus further shows the periphery of the head inclined towards the foot (at 10). The column is read as being connected to each of the plate member through the supporting means since the claim does not require direct connection.

Claim Rejections - 35 USC § 103

Claim 6 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Boik as applied to claim 1 above, and further in view of Mejso (US 3,181,411). Boik does not disclose the supporting means being formed as a wavy member. Mejso discloses a hole plug including a supporting means formed as a wavy (19-20 or 36-38). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to

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replace the support means of Boik with a wavy member as disclosed in Mejso because a wavy member as disclosed in Mejso would not only provide a means of suppressing the movement of the plate member it would provide support to the plate member for an overall strengthened and thus improved structure. Indeed, for combination to made operable the wavy member would be extending between the column and the plate member and still integrated with the back of the head. Lastly, since in Boik the height of the supporting means is less than the column, the wavy member would also be less than the height of the column once the combination was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boik as applied to claim 1 above, and further in view of Jaeger (US 6,319,436). Boik discloses the foot portion of the hole plug may be provided with interlaced guide means (28) but, does not disclose the guide means being longer than the plate members. Jaeger disclose a hole plug where as described above, there is provided a guide means (60-66) having a length longer than the plate members (see Figs. 2 and 3). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the guide means of Boik with longer ones as disclosed in Jaeger in order to provide better guidance into the hole.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boik in view of Mejso and Jaeger. In the embodiment of Fig. 14, Boik discloses a hole plug comprising a head portion (55) and a foot portion extending from the back of said

head portion. The foot portion includes a plurality of plate members (56) arranged in a cylindrical shape. Each plate member having a step (at 60) at a base (58) close to a head capable of engaging a hole (at 21). There is further provided a column (64) projecting from the back of the head which includes a plurality of supporting means (75) also integral with the back of head for suppressing the plate member from bending. Boik does not disclose the supporting means being formed as a wavy member. Mejso discloses a hole plug including a supporting means formed as a wavy (19-20 or 36-38). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the support means of Boik with a wavy member as disclosed in Mejso because a wavy member as disclosed in Mejso would not only provide a means of suppressing the movement of the plate member it would provide support to the plate member for an overall strengthened and thus improved structure. Indeed, for combination to made operable the wavy member would be extending between the column and the plate member and still integrated with the back of the head. Modified Boik discloses the foot portion of the hole plug may be provided with interlaced guide means (28) but, does not disclose the guide means being longer than the plate members. Jaeger disclose a hole plug where as described above, there is provided a guide means (60-66) having a length longer than the plate members (see Figs. 2 and 3). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the guide means of Boik with longer ones as disclosed in Jaeger in order to provide better guidance into the hole.

(10) Response to Argument

Appellant initially argues that claims 1-4 define over the reference to Boik (US 4,504,009). The examiner agrees with appellant's understanding of Boik and also generally agrees with how appellant equates the features of the claims to those disclosed in Boik.

Appellant argues the Boik cannot anticipate the claims because Boik fails to show the column (64 in Boik) "is connected to" each of the plate member (56 in Boik) through each of the supporting means (75 in Boik). In response, the examiner disagrees. While the examiner understands applicant's position and even concedes that there are distinctions between the instant invention and that of Boik, the examiner maintains the Boik continues to anticipate the claims. There does not appear to be any disagreement as which elements of the Boik corresponds to the elements of the claims the question is, in Boik: is the column connected to each of the plate members through each of the supporting means? The examiner opinions that yes, that with the claims given there broadest reasonable interpretation, the column is connected to the retaining tabs through the supporting means.

As, addressed previously, "connected" is a broad term which does not require the direct connection therefore, and as correctly inferred by appellant, the connection considered as being through the end panel 55. Now, appellant argues this would be improper since the end panel is already a required feature of the claim and could not be both the end panel and the supporting means. In responds the examiner disagrees for two reasons: First, the supporting means is only member labeled 75 thus the connection

of the column and plate member would be “though each of the supporting means” regardless of if it also goes thought the end panel it would sill meet the limitation of the claims. In other words, the claims language does not preclude the connection as being thought the end panel 55 so long as it is also though the supporting means. Second, though not preferred, the “end panel” could be interpreted and being only the upper half of the part labeled 55 in Boik thus leaving the lower half as providing the connection.

Appellant's argument that Boik teaches away from the connection is by way of their operation is moot since the reference was applied under section 102. In regards to claim 1-4, the rejection does not propose modifying the reference Boik to a structure as disclosed in the instant invention. As mentioned above, the examiner acknowledges there are differences between the instant invention and Boik but, the claims simply do not bring forth any of the differences. The claims only require “the supporting means supports and suppresses the plate member from bending inward”. There is no requirement this happen at the initial bending and as acknowledged by appellant the function will be met as the plate member is moved far enough inward to where there is a direct engagement.

Applicant next argues that claims define over Boik since they require a step portion “for engaging a hole”. Appellant does not dispute Boik as have a step portion but, argues that the step portion does not engage a lip of a hole, as disclosed or the instant application, but instead is for insertion into a container. In response, the examiner agrees but, the engagement of the step with a hole is only recited as an intended use. In that regard, a recitation of the intended use of the claimed invention

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must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, since the structure is the same, the step portion would be capable of engaging a hole in the same manner as the instant invention. Furthermore, the claims only require step portion for engaging a hole and do not remotely require the creation a seal between a plug and the rim of the hole, nor the engagement in a parallel direction, as suggested by appellant. Neither the seal nor the parallel direction is recited in the claims and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Finally, it should be recognized that Boik disclose "hole plug" because the container (21), which is engaged the plug, includes a hole and it could even be argued that if the combination were claimed Boik would still anticipate the claims.

Appellant further distinguishes by arguing that Boik does not disclose that "each of said supporting means being integrated with the back surface of the head portion". In response, the examiner disagrees because the elements 75, which are equated to the supporting means, are clearly shown as integrated to a back surface of the panel (labeled 55 in Boik). Note the continuous shading in Boik's cross sectional Fig. 14.

Appellant next argues that claims 1, 2 and 12 define over the reference to Kraus (US 4,791,319). The examiner agrees with appellant's understanding of Kraus and also

generally agrees with how appellant equates the features of the claims to those disclosed in Boik.

Appellant's arguments with regards to Kraus are the same as those levied against Boik above therefore provides the same reply. Specifically, appellant argues the Kraus cannot anticipate the claims because Kraus fails to show the column (8 in Kraus) "is connected to" each of the plate member (5 in Kraus) through each of the supporting means (9 as optionally located on the column, column 5, line 1-12 in Kraus). In response, as with Boik, the examiner disagrees. While the examiner understands applicant's position and even concedes that there are distinctions between the instant invention and that of Kraus, the examiner maintains the Kraus continues to anticipate the claims. There does not appear to be any disagreement as which elements of the Kraus corresponds to the elements of the claims the question is, in Kraus as with Boik: is the column connected to each of the plate members through each of the supporting means? The examiner opinion is again yes, that with the claims given there broadest reasonable interpretation, the column is connected to the retaining tabs through the supporting means.

As, addressed previously, "connected" is a broad term which does not require the direct connection therefore, and as correctly inferred by appellant, the connection considered as being through the end panel 4. Now, appellant argues this would be improper since the end panel is already a required feature of the claim and could not be both the end panel and the supporting means. In responds the examiner disagrees for two reasons: First, the supporting means is only member labeled 9, (when located on

the column) thus the connection of the column and plate member would be “though each of the supporting means” regardless of if it also goes thought the end panel it would sill meet the limitation of the claims. In other words, the claims language does not preclude the connection as being thought the end panel 4 so long as it is also though the supporting means. Second, though not preferred, the “end panel” could be interpreted and being only the upper half of the part labeled 4 in Kraus thus leaving the lower half as providing the connection.

Appellant’s argument that Kraus also teaches away from the connection is by way of their operation is moot since the reference was applied under section 102. In regards to claim 1, 2 and 12, the rejection does not propose modifying the reference Boik to a structure as disclosed in the instant invention. As mentioned above, the examiner acknowledges there are differences between the instant invention and Boik but, the claims simply do not bring forth any of the differences. The claims only require “the supporting means supports and suppresses the plate member from bending inward”. There is no requirement this happen at the initial bending and as acknowledged by appellant the function will be met as the plate member is moved far enough inward to where there is a direct engagement.

Applicant argues that in Kraus the adjacent holding jaws 6, which are equated to the step portions, are vertically displaced relative to one another therefore it would not be possible that each step portion 6 meet the limitation of being “at a base close to a head portion for engaging the hole”. In response, the examiner disagrees because the quoted limitation would not preclude the step portions from vertically displaced relative

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one another. As addressed in regards to Boik above, the claims are directed to the plug and any combination with the hole would be an intended use of which Kraus need only be capable of. In regards to the instant argument, the hole the perimeter of the hole could be contoured to be the same as the vertical spacing of the step portions.

Appellant next argues that claim 6 and 13 are additionally allowable over the combination of Boik in view of Mejso. Specifically, applicant argues that any combination can only be the result of hindsight particularly since this case is less technologically complex. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, although the inventions may in characterized as less complex, there nonetheless is motivation in that the supporting means disclosed in Boik can be improved by it being modified to a structure as disclosed in Mejso. Indeed, the supporting means disclosed in Boik leaves the plate member free to expand outward and possibly become damaged if not properly aligned in with the hole whereas the supporting means of Mejso would prevent any outward deflection thus providing an overall strengthened and secure structure while still retaining the supporting characteristics.

Appellant next argues that 7 is additional allowable over the combination of Boik in view of Jaeger. Specifically, appellant argues that Jaeger does not disclose the features of claim 7 as relied upon in the rejection since in Jaeger the guide means are not disposed between two of the plate members. In response, the examiner disagrees because Fig. 5 in Jaeger clearly shows the guide means (not labeled but, shown as the “+” shape in cross-section) as being disposed between the plate members (32-38) in the circumferential direction in the same manner and as in the instant invention (see Fig. 3 of the instant invention).

Appellant lastly argues that claims 10 and 11 are separately allowable. However, appellant provides no new arguments in support thereof. Instead, applicant relied on the same arguments as previously presented. Therefore, no further response is believed necessary.

In conclusion, the examiner submits that claims 1-4, 6, 7 and 10-13 have been properly rejected and the rejections be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Flemming Saether



Flemming Saether
Primary Examiner

Conferees:

Judy Swann 

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